REMARKS/ARGUMENTS

A Notice of Appeal was filed in this application on September 17, 2008. Applicant, however, is withdrawing the Appeal and herewith amending the claims and filing a Request for Continued Examination. Also, filed herewith is an Information Disclosure Statement.

Claims 1, 3-5, 7, 8, 10-12, 17-20, 22, 23 and 32-42 are amended. Claims 2, 6, 9 and 24-31 are cancelled. Claims 43-50 are new. Accordingly, claims 1, 3-5, 7, 8, 10-23 and 32-50 are presently in the application.

On page 2 of the Office action of March 17, 2008, the drawings were rejected because the drawings did not show an internal thread over the entire length of the thread section (claim 11). In the Amendment After Final filed May 19, 2008, a new Fig. 8, showing the internal thread, was provided. Applicant respectfully requests withdrawal of the drawing objection.

On page 3 of the Office action, claims 1, 3, 5, 7, 8, 10, 12, 13, 17, 18, 20, 22, 32, 33, 35, 37, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter in view of Ballantyne and Kambin. On page 9 of the Office action, claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (U.S. Patent 4,484,570) in view of Ballantyne (U.S. Patent 4,022,099) further in view of Kambin (U.S. Patent 5,964,761) further in view of Moore (U.S. Patent 6,402,757). On page 10 of the Office action, claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (U.S. Patent 4,484,570) in view of Ballantyne (U.S. Patent 4,022,099) further in view of Kambin (U.S. Patent 5,964,761) further in view of Moore (U.S. Patent 6,053,916). On page 12 of the Office action, claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (U.S. Patent 4,484,570) in view of Ballantyne (U.S. 4,022,099). Applicant respectfully traverses the rejections.

Claim 1 recites an elongated tube and an elongated holding element. The elongated tube includes a tubular wall and a bone thread on an outside surface of the tubular wall. Claim 1 also recites that "a diameter of the tube is greatest at an outer diameter of the bone thread such that the tube is fully immersed in an opening created when screwed in." Sutton does not teach this feature. The screw 11 of Sutter has an external thread 11a, but the diameter of the screw is not greatest at the thread. Instead, the diameter of the screw of Sutter is greatest at the head 11b such that the screw 11 cannot be fully immersed in an opening when screwing in. Accordingly, claim 1 is believed to be patentable over the references cited in the rejection.

Claim 17 recites a one-piece elongated tube including a bone thread on an outside surface of the tubular wall and an adjoining section free of bone thread comprising the second end of the tube. Claim 17 also recites that "a greatest diameter of the entire adjoining section free of bone thread is less than or equal to a greatest outer diameter of the bone thread of the tube such that the bone screw is fully immersed in an opening created when screwing in." For the reason noted above, Sutter does not teach this feature and, accordingly, claim 17 is believed to be patentable over the references cited in the rejection.

For similar reasons as above, independent method claim 32 is also believed to be patentable over the references cited in the rejection.

The remaining claims in the above-noted rejections depend from one of the above claims. Because these claims depend from one of the above claims, and because they contain additional limitations further distinguishing these claims from the cited prior art when considered as a whole, these claims are also believed to be patentable.

On page 7 of the Office action, claims 4, 34, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (U.S. Patent 4,484,570) in view of Ballantyne (U.S. Patent 4,022,099) further in view of Kambin (U.S. Patent 5,964,761) further in view of Tronzo (U.S. Patent 4,940,467). Applicant respectfully traverses the rejection.

Claims 4, 34, 36 and 41 each recite that the tube and holding element are fixed to each other to form a press fit that prevents "movement in opposite directions along the longitudinal axis." Tronzo does not teach this feature. Instead, Tronzo teaches "uninhibited movement" (col. 5, lines 30-32) between the tube 11 and the portion 30, i.e., they are not press fit to prevent movement in opposite directions along the longitudinal axis. Accordingly, these claims are believed to be patentable over the rejection.

On page 8 of the Office action, claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (U.S. Patent 4,484,570) in view of Ballantyne (U.S. Patent 4,022,099) further in view of Kambin (U.S. Patent 5,964,761) further in view of Tronzo (U.S.

Patent 4,940,467) further in view of Boothroyd (Product Design for Manufacture and Assembly). Applicant respectfully traverses the rejections. On page 13 of the Office action, claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (U.S. Patent 4,484,570) in view of Ballantyne (U.S. 4,022,099) further in view of Boothroyd (Product Design For Manufacture and Assembly). Applicant respectfully traverses the rejection.

Boothroyd is not pertinent because it provides no teaching pertaining to threads, and threads do not have rotation symmetry. Further, claim 21 is contrary to Boothroyd because it does not recite end-to-end symmetry. Instead claim 21 recites a bone thread and an adjoining section free of bone thread. Accordingly, these claims are believed to be patentable over the rejections.

On page 9 of the Office action, claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (U.S. Patent 4,484,570) in view of Ballantyne (U.S. Patent 4,022,099) further in view of Kambin (U.S. Patent 5,964,761) further in view of Moore (U.S. Patent 6,402,757) further in view of Tronzo (U.S. 4,940,467). Claim 27 is cancelled without prejudice.

On page 11 of the Office action, claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tipirrneni (U.S. Publication 2004/0172030) in view of Sutter (U.S. Patent 4,484,570). On page 12 of the Office action, claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tipirrneni (U.S. Publication 2004/0172030) in view of Sutter (U.S. Patent 4,484,570) further in view of Klaue (U.S. Patent 4,705,027). Applicant respectfully traverses the rejections.

Claim 1 recites that "the length of the middle section of the holding element extending along the longitudinal axis is greater than the greatest outer diameter of the bone thread of the tube" and "the holding element is suitable to transfer torque applied to the second end section from a screw-in tool to the tube to screw-in and fully immerse the tube into a bone." Tipirrneni does not teach both of these features. In particular, wire 12 is used as a tensioner, but is nowhere described as being suitable to transfer torque applied at one end to screw-in a tube at the other end, as recited in Claim 1. Alternatively, tool attachment 10 is used to screw in head component 2, but the length of the middle section of tool attachment 10 is not described to be greater than the greatest outer diameter of the bone thread of the tube, as recited in claim 1. Accordingly, claims 1 and 23 are believed to be patentable over the rejections.

In view of the above, applicant respectfully requests reconsideration of the application and the allowance of claims 1, 3-5, 7, 8, 10-23 and 32-50.

Respectfully submitted,
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